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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/634691	**Applicant(s)** Hoyt A. Fleming III
Examiner Hiou C. Le	**Group Art Unit** 2153

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___3___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on ___8-8-00___.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) ___1-14, 16, 19-28___ is/are pending in the application.

     Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) ___1-14, 16, 19-28___ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

     ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

     ☐ received.

     ☐ received in Application No. (Series Code/Serial Number)_____.

     ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

     *Certified copies not received:_____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). ___2___   ☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892   ☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948   ☐ Other_____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 25 recites the exact steps of claim 1.

Claim 26 recites the exact steps of claim 2.

Claim 27 recites the exact steps of claim 3.

Claim 28 recites the exact steps of claim 4.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
>
> States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention

thereof by the applicant for patent.

4. Claims 5-9 are rejected under 35 U.S.C. 102(e) as anticipated by Birrell et al. [US. Pat.

No. 6,092,101].

As to claim 5, Birrell discloses a method in a computer system for filtering unauthorized

messages, each message having a sender, the method comprising:

for each of a plurality of messages (Fig. 9, item 930),

determining whether the sender of the message is designated as being authorized [each

new message compared with named filter queues 910 (a filter that removes a message sent by a

specified sender) to determine if the message is authorized (col. 11, lines 27-41)];

when the sender of the message is determined to be authorized, indicating that the

message is from an authorized sender [if the message does not match any of the named filter

queues, the message is placed in the Inbox (col. 11, lines 41-44) i.e the message is indicated by a

label Inbox for the user's attention]; and

when the sender of the message is determined to be not authorized, indicating that the

message is from an unauthorized sender [otherwise the new message 920 is only given the unreal

label (col. 11, lines 45-46) i.e when the message matches any the filter queries it is labeled unread

i.e not important message].

As to claim 6, Birell further discloses wherein the recipient of the messages

can identify whether a message is authorized based solely on the indications [the messages are labeled as Inbox that are deemed to require the user's attention or labeled unread which is not important (col. 9, lines 9-15)].

As to claim 7, Birell further discloses wherein the message is indicated as authorized by storing in a pre-designated location for messages sent by authorized senders [the message is stored in the Inbox location (which is for messages from authorized senders) (col. 11, lines 44-45).

As to claim 8, Birell further discloses wherein the message is an electronic mail message and the pre-designated location is a folder (col. 8, lines 26-48).

. As to claim 9, Birell further discloses including when displaying a list of messages, displaying a visual indication as to whether the message has been indicated as being sent from an authorized or unauthorized sender [the messages are displayed and labeled as Inbox or unread (col. 9, lines 9-18)].

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-4, 11-14, 16, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Birrell et al. [US. Pat. No. 6,092,101] in view of Hashimoto et al. [US. Pat. No. 5,931,905].

As to claim 1, Birrell discloses a method in a computer system for filtering unauthorized

electronic mail messages that are sent by senders to a user, each sender having an identification

(col. 11, lines 47-49) each electronic mail message including the identification of the sender, the

method comprising:

providing a list of the identifications of the senders who are not authorized to send an

electronic mail message to the user [an e-mail filter is specified as one or more name "filter

queries 910, stored in a memory on a client computer (col. 11, lines 28-35) i.e a list of filters are

stored to filter a sender using his name i.e the sender is unauthorized];

for each of a plurality of electronic mail messages (fig. 9, item 930),

determining whether the sender of the electronic mail message is not authorized by

determining whether the identification of sender in the electronic mail message is in the provided

list of the identifications of the senders who are not authorized [each new message 930 is

compared with the named filter queries 910 (col. 11, lines 39-41) i.e each new message is matches

with list of unauthorized sender "filter queries" to determine whether the sender exists in the

unauthorized list];

when the sender of the electronic mail message is determined to be authorized, storing the

electronic mail message in a first folder designated for electronic mail messages received from

authorized senders [when the new message 930 does not match any of the named filter queries

910 then the new message 930 is given the Inbox label 710 (col. 11, lines 41-43, fig. 9, item 940)

i.e when the name of the sender of the E-mail does not exist in the unauthorized list, the sender is

considered authorized and the message is sent to the Inbox];

when the sender of the electronic mail message is determined to be not authorized, storing

the electronic mail message in a second folder designated for electronic mail messages received

from unauthorized senders [otherwise the new message 920 is only given the unread label (col.

11, lines 45-46) i.e when the message matches any of the named filter queries, the sender is on the

unauthorized list and he is considered unauthorized list sender and the message is labeled unread];

whereby the electronic mail messages are automatically stored in the appropriate folder

based on whether the sender is authorized so that the user can view the first folder containing the

electronic mail messages sent by authorized senders separately from the second folder containing

the electronic mail messages sent by unauthorized senders (col. 9, lines 4-15).

Birell uses one or more name "filter queries" that are stored in a memory on a client

computer to filter or remove messages sent by unauthorized senders (i.e a list of unauthorized

senders) by matching the e-mail messages with the list of the unauthorized senders (the name filter

queries).

Birrell does not use a list of authorized senders to filter the incoming e-mail.

Hashimoto discloses a TV electronic mail system that uses an "authorized sender list"

having identification numbers of the users permitted to send electronic mails and store it in an

authentication database (col. 12, lines 37-41). If the user ID has been registered in the list the e-mail is sent to the receiver's mail box and if the user ID of the sender is not registered in the authorized sender list, the e-mail is abolished (deleted) (col. 12, line 67-col. 13, line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hashimoto's teaching to modify Birrell's method by using an "authorized sender list" to filter the incoming e-mail in order to facilitate mail handling, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

As to claim 2, Birrell further discloses wherein when the user sends an electronic mail message to a recipient, the identification of the recipient is automatically added to the provided list of the identifications of senders who are authorized to send electronic mail message to the user [the queries that are used in the filter queries perform the function of prior art address books to frequently used addresses (col. 10, lines 22-24)].

As to claim 3, Birrell further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of senders of previously received electronic mail messages (col. 10, lines 65-66).

As to claim 4, Birrell further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of recipients of previously sent electronic mail messages (col. 10, lines 65-67).

As to claim 11, Birrell does not disclose wherein the computer system includes a list of authorized senders and wherein the determining whether the sender of the message is designated as being authorized includes determining whether the sender is in the list of authorized senders.

Hashimoto discloses a TV electronic mail system that uses an "authorized sender list" having identification numbers of the users permitted to send electronic mails and store it in an authentication database (col. 12, lines 37-41). If the user ID has been registered in the list the e-mail is sent to the receiver's mail box and if the user ID of the sender list, the e-mail is abolished (deleted) (col. 12, line 67-col. 13, line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hashimoto's teaching to modify Birrell's method by using an "authorized sender list" to filter the incoming e-mail in order to facilitate mail handing, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

As to claim 12, refer to claim 3 rejection.

. As to claim 13, refer to claim 4 rejection.

As to claim 14, Birrell further discloses wherein the list is shared by multiple users (col. 2, lines 44).

As to claim 16, refer to claim 2 rejection.

As to claim 19, Birrell further discloses wherein the indicating that the message is from an unauthorized sender includes deleting the message (col. 9, lines 19-23).

As to claim 20, refer to claim 1 rejection.

As to claim 21, refer to claim 2 rejection.

As to claim 22, refer to claim 3 rejection.

As to claim 23, Birell labels a message received from an unauthorized sender as unread

(col. 9, lines 9-15) the labels are folder (col. 8, lines 26-33). Birell uses the filters to filter out Junk

e-mail (col. 5, lines 57-66 & col. 11, lines 58-59).

Birell does not explicitly disclose that the folder is labeled Junk mail. However, it is

obvious to label a folder that is labeled unread and contains filtered e-mail from unauthorized

sender and is used in the context of filtering Junk mail to be labeled Junk mail.

As to claim 24, refer to claim 19 rejection.

7.   Claim 10, is rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al. [US.

Pat. No. 6,092,101] as applied to claim 9 and further in view of Microsoft Corporation, "Excerpts

from online documentation of Microsoft Exchange", version 5.0.1458.47, 1986-1997, 11pp.

As to claim 10, Birell does not disclose the limitation, wherein the visual indication is the

dimming of the messages that are sent from unauthorized senders in the list of messages.

Microsoft Corporation discloses a visual indication method used in e-mail message to dim

profile message (page 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was

made to use Microsoft's teaching to modify Birrell's system by dimming the junk mail messages in

the list of messages in order to indicate to the user that these messages are irrelevant to his

interest and save him valuable hours to be wasted in dealing with junk mail.

8.   Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al. [US.

Pat. No. 6,092,101] as applied to claim 5 and further in view of Canale et al. [US. Pat. No.

5,619,648].

As to claim 17, Birrell does not disclose wherein the indicating that the message is from an

unauthorized sender includes forwarding the message to another user.

Canale discloses a method for reducing the amount of junk e-mail received by a user of an

e-mail system. The mail filter for potential recipient has access to a list of the e-mail messages sent

and received by the potential recipient and used the list of e-mail messages to determine

correspondents of the potential recipient and forwards the messages to those recipients (col. 2,

lines 27-44). The system permits the recipient of the e-mail to select which of the correspondents

(another users) is to receive the e-mail (col. 4, lines 2-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was

made to use Canale's teaching to modify Birell's method in order to facilitate mail handling,

particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail

he receives.

9.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Examiner Hieu Le whose telephone number is (703) 306-3101. The

examiner can normally be reached on Monday to Friday from 8:00 A.M.to 4:00 P.M..

The fax number of this Group 2757 is (703) 308-5397 or 308-9051 .

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group receptionist whose telephone number is (703) 305-3900.

MOUSTAFA M. MEKY
PRIMARY EXAMINER